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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,204	10/06/2005	Bethany Johnson	DC5109 PCT1	6332
137 7590 06/18/2009 DOW CORNING CORPORATION CO1232 2200 W. SALZBURG ROAD P.O. BOX 994 MIDLAND, MI 48686-0994				
EXAMINER VENKAT, JYOTHSNA A				
ART UNIT		PAPER NUMBER		
1619				
NOTIFICATION DATE		DELIVERY MODE		
06/18/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

# Office Action Summary

**Application No.**

10/552,204

**Applicant(s)**

JOHNSON ET AL.

**Examiner**

JYOTHSNA A. VENKAT

**Art Unit**

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date 10/6/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Receipt is acknowledged of IDS filed on 10/6/05. Claims 1-16 are pending in the application.

#### *Claim Rejections - 35 USC § 112*

Claims 10-16 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for emulsion under example 2 following the steps i-v claimed using specific trimethyl siloxane terminated amino functional siloxane with DP about 300 and using nonionic surfactant, does not reasonably provide enablement for oil-in-water emulsion (O/W) or water-in-oil emulsion (W/O) using silanes having a nitrogen atom and surfactant or siloxanes having a nitrogen atom using cationic surfactant or anionic surfactant or amphoteric surfactant or non-ionic surfactant and using any cross-linking agent in step IV to form the emulsions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “*undue*”. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ 2d 1400, 1404 (Fed. Cir. 1998). The court set forth the eight factors to consider when assessing if a disclosure would require undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546, the court recited eight factors

These factors include, but are not limited to:

- 1) *The breadth of the claims,*
- 2) *The nature of the invention,*

- 3) *The state of the prior art,*
- 4) *The level of one of ordinary skill,*
- 5) *The level of predictability in the art,*
- 6) *The amount of direction provided by the inventor,*
- 7) *The existence of working examples*
- 8) *The quantity of experimentation needed to make or use the invention based on the content of the disclosure.*

(1 and 2) The breadth of the claims and the nature of the invention: The claims are drawn to method of preparing emulsions using the starting materials siloxanes or silanes having nitrogen atoms.

Specification under paragraphs [0018-0020] describes the silanes with amino groups ( emphasis added) and under paragraph [0020] describes two polymers under siloxanes with nitrogen atoms. Example 2 is also drawn to starting material amino functional siloxane. Specification under paragraph[0021] describes the cross linking agent.

(3 and 5) The state of the prior art and the level of predictability in the art: The Art is unpredictable in view of preparing elastomeric silanes or siloxanes having nitrogen atoms instead of conventional fluid siloxanes or silanes having nitrogen atoms

*(6-7) The amount of direction provided by the inventors and the existence of working*

examples: Applicants under example 2 teaches trimethyl siloxy terminated amino

functional siloxane and there is no cross linking agent in the preparation of example 2.

Applicants' attention is drawn to the cross linking agent claimed in claim 10 or specific cross linking agent claimed in claim 13

*(8) The quantity of experimentation needed to make or use the invention bases on the*

content of the disclosure: The claims recite "silanes or siloxanes having nitrogen atom"

or "surfactant" or "cross linking agent" or various cross linking agent of claim 13. The

instant specification gives one skilled in the art no indication that the one could use the

combination of "silanes or siloxanes having nitrogen atom" or "surfactant" or "cross

linking agent" in preparing the elastomeric siloxanes or silanes and have a reasonable

expectation of success. Therefore further testing would be necessary to use the claimed

invention and the practice of the full scope of the invention would require undue

experimentation.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8-9 and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by U. S.

Patent 6,787,603 ('603).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

It is noted that claims 8-9 and 15-16 are a product-by-process claim wherein Applicant claims a product containing an emulsion or elastomeric silane or siloxane that is made by the process of a previous claim. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by- process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process" *In re Thorpe*, 777 F.2d 695, 698,227 USPQ 964,966 (Fed. Cir. 1985).

See examples 1-6.

Accordingly, the emulsion contemplated by claims 8 and 15 and the silanes or siloxanes prepared in claims 9 and 16 need not necessarily be derived from the same process that is outlined in claims 1 or 10.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 and 10-13 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of U.S. Patent No. 6,787,603 ('603). Although the conflicting claims are not identical, they are not patentably distinct from each other because instant application and patent are claiming emulsions and micro emulsions using the same starting materials. The only difference with respect to instant claims 1-6 is, instant application is claiming the additional reactant "cross linking agent".

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.). Using the transitional phrase "consisting of" excludes any element, step, or ingredient not ~specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448,450 (Bd. App. 1948).

Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/552,537. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-7 and 10-14 of co-pending application is claiming method of treating hair or skin or under arm using the same emulsion claimed in instant application. With respect to claims 8-11 and 17-20 of co-pending application these claims are drawn to products and it is obvious to use the claimed emulsions for the products claimed in the copending application

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /  
Primary Examiner, Art Unit 1619